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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/796,519 02/07/97 INQUE

H 684.2213-DIV

EXAMINER

MM91/0104

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HARPER & SCINTO
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NEW YORK NY 10172

HALLACHER, C	ART UNIT	PAPER NUMBER
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2853

DATE MAILED:

01/04/01

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/796,519

Applicant(s)

INOUE ET AL.

Examiner

Craig A Hallacher

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 43-149 is/are pending in the application.
- 4a) Of the above claim(s) 102-108, 134-138 and 148 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 43-101, 109-133 and 149 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10-12.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I., claims 1, 43-101, 109-133, 139-146 and 149 in Paper No. 18 is acknowledged. The traversal is on the ground(s) that there is no serious burden established because a first action on the merits has already been established. This is not found persuasive because there is a clear burden on the Examiner to examine four distinct inventions. The different classifications for all of the inventions is evidence that there is a burden on the examiner because four divergent searches would need to be maintained in order to properly examine all of the inventions. Thus, there is a clear burden to examine all of the claimed inventions.

The requirement is still deemed proper and is therefore made FINAL.

Specification

2. A substitute specification excluding the claims is required pursuant to 37 CFR 1.125(a) because the lengthy amendment filed on 2/6/97 would make it difficult to properly consider the case. This requirement was first made in Paper No. 6. Therefore, a substitute specification must be filed in order to constitute a proper response to the Office Action.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the

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amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 43-101, 109-133, 139-147 and 149 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 43-101, 109-133, 139-147 and 149 are rejected for being unduly multiplied as containing an unreasonable number of claims so as to confuse the issue. That is 86 claims is deemed to be unreasonable number of claims in view of the nature and scope of applicant's invention, primarily an ink container for use in an inkjet printer. The Applicant should limit the number of claims of to the elected invention to 42. See M.P.E.P. 2173.05(n).

On 12/28/00, the Examiner telephoned Michael K. O'Neill, to inform the Applicant of the multiplicity rejection and to allow for the opportunity of an election of claims to be examined. However, Mr. O'Neill was unavailable at this time. The Examiner apologizes for the delay in the multiplicity rejection. This rejection could not be given until the election of invention was received because Groups II-IV. all contained twelve or less claims. An election of any of these Groups would have alleviated the need for the multiplicity rejection.

Response to Arguments

5. Applicant's arguments with respect to claims 1, 43-101, 109-133, 139-147 and 149 have been considered but are moot in view of the new ground(s) of rejection. Applicant's traversal of the requirement for a substitute specification is noted. However, Applicant's preliminary amendment contains 16 pages of amendments to the specification. This unduly large number of changes renders the specification unclear and difficult to consider. As Applicant noted (page 31 of arguments) 37 C.F.R. 1.125 allows for a substitute specification when the number of changes render it difficult to consider the case. Applicant's argument that parent Application was able to issue with these same changes is not deemed to be persuasive because these changes do make it difficult to consider the case.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Craig A Hallacher whose telephone number is (703)308-0516. The examiner can normally be reached on M-F (8:30-6:00) First Friday Off.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow, Jr. can be reached on (703)308-3126. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3432 for regular communications and (703)305-3432 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.



Craig A Hallacher
Examiner
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C.A.H.
December 29, 2000